In the Supreme Court of the United States

OCTOBER TERM, 1974

No. 74-957

MRS. WINSTON CALDWELL, ADMINISTRATRIX, ET AL., PETITIONERS

v.

UNITED STATES OF AMERICA

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CLAIMS

MEMORANDUM FOR THE UNITED STATES IN OPPOSITION

In 1953 Winston Caldwell, deceased, filed a patent application for a "thermionic converter" consisting of two closely-spaced electrodes (an emitter and a collector) spaced approximately 0.02 inches apart with a vacuum between them. By increasing the temperature of the emitter and decreasing the temperature of the collector, electrons are emitted and electrical current generated. With only one prior-art reference cited to the Patent Office, Caldwell's patent application was granted in 1956. In 1960, the patent was reissued on an application filed in 1958 (481 F.2d 898, 899-901 (Ct. Cl.)).

Petitioners filed suit in the Court of Claims against the United States seeking to recover compensation for the alleged unauthorized use by the government of the inventions described in Caldwell's patent. In response the government challenged the validity of the patent on the grounds,

inter alia, that Caldwell's device was both "anticipated" under 35 U.S.C. 102 and "obvious" under 35 U.S.C. 103 from prior-art references at the time of invention. After considering these references, which had not previously been brought to the attention of the Patent Office, the Court of Claims denied petitioners' claim for compensation. The court held that petitioners' patent claims were invalid due to "obviousness" under 35 U.S.C. 103, and therefore found it unnecessary to consider the other defenses raised by the government. 481 F.2d at 899.

After the Court of Claims denied petitioners' motion for rehearing, petitioners filed a petition for a writ of certiorari in this Court, which was denied on April 15, 1974 (416 U.S. 938). Petitioners then filed a motion with the Court of Claims for relief from judgment pursuant to Court of Claims Rule 152(b)[1] which was denied by the Court of Claims on October 10, 1974. Petitioners thereupon filed this second petition for a writ of certiorari.

Petitioners contend that the Court of Claims' denial of their motion for relief from judgment presents the question whether Court of Claims Rule 152(b) should be applied consistently with Rule 60(b) of the Federal Rules of Civil Procedure, to which it is substantively identical (Pet. 1). But Rule 152(b) was not applied inconsistently with Rule 60(b) in the instant case. Both provisions give trial courts substantial discretion in determining whether to relieve a party from a final judgment upon newly discovered evidence or alleged misrepresentation. Nor did the Court of Claims in the instant case abuse its discretion.

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[1]Rule 152(b) of the Rules of the Court of Claims is substantially identical to Rule 60(b) of the Federal Rules of Civil Procedure. Rule 152(b) provides, in pertinent part, that

> * * * On motion * * * and upon such terms as are just, the court may relieve a party or his legal representative from a final judgment * * * for the following reasons: * * * newly discovered evidence * * *; fraud * * * misrepresentation, or other misconduct of an adverse party * * *.

Petitioners allege that the Court of Claims based its holding of invalidity upon the testimony of a government witness who stressed the obviousness of spacing the electrodes as closely together as possible without their touching (Pet. 2), but that an Atomic Energy Commission report, subsequently discovered by petitioners, shows that, to the contrary, electrodes placed too closely together lose voltage. Therefore, according to petitioners, on the basis of this newly discovered evidence, or government misrepresentation, the Court of Claims should have granted their motion for relief from judgment pursuant to Rule 152(b) (Pet. 3).

The Court of Claims, however, did not base its holding upon the testimony of the government witness. Indeed, it relied in large part upon its finding that Caldwell's idea for electrode spacing "came from the prior art of radio tubes" (481 F.2d at 904-905):

> Plaintiffs make much of the fact that the prior art does not expressly teach electrode spacing of 0.02 inches or less, which is the spacing disclosed (but not claimed) by Caldwell. Schlichter, in 1915, taught electrode spacing of about 0.20 inches. Langmuir's work on "space charge" effects in 1923 suggests that electrodes must be closely-spaced in order to get significant current flow. Champeix, in 1951, recognizing the "space charge" problem, taught that the electrodes should be very closely-spaced. In view of such teachings, it seems obvious that one would desire to place the electrodes as close together as possible without actually touching. In any event, it appears that Caldwell's teaching of 0.02 inches electrode spacing is based on the fact that the 35Z5 radio tube, with which he did experimental work, had electrode spacing of 0.015 inches. In early correspondence with his patent attorney, Caldwell suggested a spacing of 0.015

> inches, but later (for unexplained reasons) changed to 0.02 inches. *Caldwell's disclosure of electrode spacing therefore came from the prior art of radio tubes*, and was not based upon any independent finding by Caldwell that such spacing was significant to thermionic conversion. Caldwell taught nothing more than was clearly suggested by the prior art. [Emphasis supplied.]

The Court of Claims did not, therefore, abuse its discretion in denying petitioners' motion for relief from judgment, since the evidence contained in the Atomic Energy Commission report would not necessarily have altered the court's holding.

For the foregoing reasons, it is respectfully submitted that the petition for a writ of certiorari should be denied.

ROBERT H. BORK,
Solicitor General.

MARCH 1975.